

REMARKS/ARGUMENTS

Claims 2-4, 7-8, 11-16 and 18-19 have been resubmitted. Claims 1, 6, 10 and 17 are currently amended. Claims 5 and 9 are canceled without prejudice or disclaimer of subject matter. Claims 20-38 were canceled in previous amendment.

The Examiner determined that proposed amendments submitted in an Amendment After Final of February 12, 2008 would not be entered because claim 6 raises a new issue that will require further consideration and a new search. Furthermore, the Examiner has determined that a request for reconsideration submitted with the February 12, 2008 amendment has been considered but does not place the application in condition for allowance. In particular, the Examiner considers a rejection under 35 USC 112 to be not overcome because a term "transition metal" remains in the independent claims. Secondly, the Examiner considers a rejection under 35 USC 102 of claim 1 to be not overcome because Wyatt (GB 2056424) anticipates the claim.

Examiner Interview

On March 5, 2008 Applicants' attorney briefly engaged in a telephone interview with the Examiner. The principal matter discussed in the conversation related to interpretation of a reference Wyatt (GB 2056424). The Examiner expressed an interpretation to the effect that, because Wyatt specifically enumerates Ti, Pd and Ag (among other elements) as potentially useful elements in an ozone removal system, Wyatt anticipates the invention of claim 1.

Applicant appreciates the opportunity to learn of this interpretation and has provided an alternative interpretation of the Wyatt reference hereinbelow.

Claim Amendments

Claims 1, 6, 10, and 17 are amended to delete the term “transition”.

Claim 1 is amended to define “an ozone removal system [that] is resistant to poisoning by sulfur and phosphorus compounds whereby the ozone removal system operates for an extended period without catalyst deactivation”
Claim 6 is amended to define an “ozone removal system {that} is operable for at least 20,000 hours without catalyst deactivation”. Support for these features is found in paragraphs [0040], [0041] and [0069] of the originally filed specification.

Rejection under 35 U.S.C. 112

The Examiner has objected to use of a phrase “transition metal” in claims 1, 6, 10 and 17. This objection appears to be based on the premise that the term “transition metal” (which is claimed to be excluded from a catalytic composition) may arguably be inclusive of palladium (which is claimed to be included in the catalytic composition).

Without acquiescing to the Examiner’s point of view, applicant has nevertheless amended his claims 1, 6, 10 and 17 to delete the term “transition” as a modifier for any metal or compound.

Applicant submits therefore that claims 1, 6, 10 and 17 as amended are sufficiently definite to overcome the objections raised by the Examiner.

Furthermore, applicant submits that because claims 10-19 were rejected **only** under 35 U.S.C. 112, these claims 10-19 should now be deemed allowable.

Wyatt (GB 2056424)

Wyatt discloses an ozone removal system for an aircraft that may employ catalytic materials selected from “the group consisting of Pt, Ru, Rh, Pd, Ir, Os, Fe, Co, Ni, Ag, Mn, and Sn alloys, mixtures and compounds containing one or more of these metals” (lines 31-32). Wyatt further discloses that a washcoat of a catalytic structure may comprise a refractory metal oxide selected from the group “B, Al, Ba, Sr, Ca, Mg, Be, Si, Ti, Zr, Sc, Y and the rare earths” (line 36).

The Examiner asserts that Wyatt anticipates previously submitted claim 1 because one can find the combined materials of claim 1 (i.e., titania, palladium and silver with nickel and manganese expressly excluded) in one of the possible combinations that may be made from the elements disclosed in Wyatt. In support for that point of view, the Examiner cites MPEP 2131.02 and in particular the phrase “A reference that clearly names the claimed species anticipates the claim no matter how many other species are named”.

Applicant respectfully submits that his claimed combination of elements is not clearly named in Wyatt. Wyatt’s disclosed elements may be combined into millions of possible species. Wyatt has named a few of these species such as: 1) Pt, Ag and Mn; 2) Pt, Pd, Fe, Ag and Mn; 3) Platinum on alumina; 4) 5.5% Rh, 94.5% Pt on alumina; 5) Platinum and silver on alumina; 6) Palladium on alumina; 7) 331/3% Pd 662/3%Pt on alumina; 8) Silver on alumina; 9) Manganese dioxide on alumina; 10) Manganese sesquioxide on alumina; and 11) Triron tetroxide on alumina.

Wyatt has “clearly named” only eleven of the possible millions of species that may be part of the genus “one or more of Pt, Ru, Rh, Pd, Ir, Os, Fe, Co, Ni, Ag, Mn, and Sn alloys, mixture and compounds containing one or more of these metals ... on a layer of refractory oxide metals selected from the group B, Al, Ba, Sr, Ca, Mg, Be, Si, Ti, Zr, Sc, Y and the rare earths ”.

Applicant has claimed a species that is not clearly named in Wyatt, i.e., Pd and Ag on titania with no Mn or Ni. Of the eleven species described by Wyatt, all but two include alumina as a washcoat, not titania as claimed. The other species (1 and 2) describe Mn as a component.

While MPEP 2131.02 states that “A reference that clearly names the claimed species anticipates the claim no matter how many other species are named”; it must be recognized that MPEP 2131.02 also states “A genus does not always anticipate a claim to a species within a genus”. The first of these phrases appears to be extracted from *Ex parte A*, 17USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). In that case, the Board noted that “It has not been controverted that the name of the compound disclosed corresponds to the formula presented in appellants’ claim 1”. In other words, unlike the present invention, *Ex parte A* is about a compound that is **clearly named** in a reference. Furthermore it was noted by the Board that as a policy matter “the Patent and Trademark Office shall continue to interpret 35 USC 102(a) literally”. In that regard the Board found that when a compound **is named** in a document such as the Merck Index then the compound is “‘described’ as that term is used in 35 USC 102(a)”.

The Board noted that the converse might also be an operative principle. It noted that it may not be appropriate to find anticipation when “to arrive at the

claimed subject matter, it was necessary to select portions of that subject matter from various sections of the reference disclosure and combine them” in a manner “somewhat reminiscent of the lexicographer who described his dictionary as ‘a poem about everything’ ”.

Applicant submits that a finding of anticipation of claim 1 within Wyatt is indeed analogous to deriving a poem from a dictionary.

Applicant's invention goes substantially beyond the subject matter disclosed in Wyatt. The invention of claim 1 would not be produced merely by indiscriminately combining the elements disclosed in Wyatt. The combination of material defined in claim 1 provides for “an ozone removal system [that] is resistant to poisoning by sulfur and phosphorus compounds whereby the ozone removal system operates for an extended period without catalyst deactivation”. Wyatt is silent on the issue of choosing combinations of materials to provide for longevity of an ozone removal system.

Wyatt simply does not disclose that, out of a group of twenty two elements, three particular elements, titanium, silver and palladium, should be included in an ozone removal system while other particular elements, manganese and nickel, should be excluded. Therefore applicant respectfully requests that Wyatt be withdrawn as a reference against claims 1-4.

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Reply to Advisory Action of March 3, 2008

CONCLUSION

Applicant appreciates the opportunity extended by the Examiner to discuss issues relating to rejected claims in a telephone interview.

Reconsideration and withdrawal of the Office Action with respect to Claims 1-4, 6-8 and 10-19 is requested. Allowance of claims 1-4, 6-8 and 10-19 is requested.

In the event the examiner wishes to discuss any aspect of this response, please contact the attorney at the telephone number identified below.

The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 50-0851:

Respectfully submitted,

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